

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patentee: Stephen Almeida
Title: Multiple Pulse Photo-Epilator
Serial No.: 09/173,422
Filing Date: October 15, 1998
Patent No.: 6,228,074
Issue Date: May 8, 2001
Date:

**PETITION TO ACCEPT DELAYED PAYMENT
OF MAINTENANCE FEES UNDER 37 C.F.R. § 1.378(b)**

Mail Stop PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a petition under 37 C.F.R. § 1.378(b) to accept the delayed payment of maintenance fees due on the above-identified patent, on an expedited basis, whereby the patent will not be considered as having been expired. This petition is filed on behalf of Stephen Almeida, who is the inventor of U.S. Patent No. 6,228,074, the above-identified patent (the Petition Patent).

Patent No. 6,228,074 was issued on May 8, 2001. The first maintenance fee was paid in accordance with the provisions of 37 C.F.R. § 1.362(e)(1) on. The second maintenance fee could have been paid with the surcharge set forth in 37 CFR 1.362(e)(3) as late as June 8, 2009. Since the third maintenance fee was not paid, Patent No. 6,228,074 expired after midnight on June 8, 2009.

A petition to accept an unavoidably delayed payment of a maintenance fee must include:

- (1) the required maintenance fee set forth in 37 C.F.R. § 1.20 (e) through (g);
- (2) the surcharge set forth in 37 C.F.R. § 1.20(i)(1); and
- (3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

MAINTENANCE FEE

The required maintenance fee of \$1,425.00 as set forth in 37 C.F.R. § 1.20(f) is enclosed herewith.

SURCHARGE

The required surcharge of \$700.00 as set forth in 37 C.F.R. § 1.20(i)(1) is enclosed herewith.

SHOWING OF UNAVOIDABLE DELAY

A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent is set forth below and in the attached declarations in support of this petition.

The delay in the payment of the maintenance fee due on this patent was unavoidable as a result of a mishap in the transfer of files from a previous law firm, Brown Rudnick that paid the

first maintenance fee and was docketing the future payments, to a new firm Seyfarth Shaw. Brown Rudnick apparently inadvertently failed to transfer both electronic and physical files to Seyfarth Shaw, the successor firm of Brown Rudnick, despite written instructions from the client. Seyfarth Shaw did not receive the client requested file transfer, and that caused notices of patent maintenance fees due and expiration notice of the Petition Patent to be apparently inadvertently received by and not processed by Brown Rudnick.

The attached declarations of Stephen Almeida (Exhibit A), June Kaps (Exhibit B), Edwin Colon (Exhibit C) and John Serio (Exhibit D) clearly establish that Brown Rudnick, the law firm which prosecuted the application from which the above-identified patent matured, had received instructions to transfer the files associated with the Petition Patent and apparently failed to transfer said file to Seyfarth Shaw that had a reliable docket system to ensure timely payment of maintenance fees; that an inadvertent file transfer error by Brown Rudnick caused the docket records at Seyfarth Shaw to not be updated to reflect the maintenance fees that were due for the Petition Patent and, as a result of the file transfer error, the physical and electronic files were not received by Seyfarth Shaw causing the matter of the Petition Patent to not be entered in Seyfarth Shaw's docketing system and the correspondence address to not be updated at the Patent Office. Stephen Almeida, who was of the belief that all of his files had been transferred to Seyfarth Shaw, was not familiar with routine prosecution and maintenance fee related issues. Almeida did not intend to let his patents expire and intended that maintenance fees be paid (Almeida Decl. ¶10).

The above-noted declarations along with the Patent Maintenance Fee records at the United States Patent and Trademark Office (USPTO) establish the unavoidable nature of the failure to pay the maintenance fee.

A. The attached declarations of June Kaps, Edwin Colon and John Serio establish unavoidable delay. More specifically:

1. Seyfarth Shaw has a complete and reliable system for docketing deadlines pertaining to USPTO proceedings, including deadlines for payment of maintenance fees. This system included a well known patent docketing software program from Computer Packages Inc. called “CPI” (Kaps Decl. ¶10). This state of the art software program calculates future deadlines from information entered into the program and produces reminders of those deadlines. During the transfer of physical and electronic files from Brown Rudnick to Seyfarth Shaw, Seyfarth Shaw contracted with CPI to retrieve all electronic docketing information related to all clients that requested transfer of their files from Brown Rudnick to Seyfarth Shaw (Kaps Decl., ¶¶14–16).. The transfer of over 700 active files and several thousand inactive files was coordinated between the docketing and file room personnel of both Seyfarth Shaw and Brown Rudnick. To ensure redundancy and best practices for the transfer of numerous clients from Brown Rudnick to Seyfarth Shaw, Seyfarth Shaw’s docketing clerk June Kaps, as stated in her declaration, had extensive experience in docketing matters (Kaps Decl., ¶¶5–7). Ms. Kaps had specific procedures in place to ensure that every physical file received by Seyfarth Shaw would be properly entered into Seyfarth Shaw’s docketing system and that the transfer of these files would be confirmed by the electronic data dump of docketing information performed by CPI (Kaps Decl., ¶15).

2. To petitioner’s knowledge and belief, Brown Rudnick’s docket system reflected the due dates for the maintenance fees for the Petition Patent, as it had previously paid the 3.5 year maintenance fee for the Petition Patent.

3. John Serio (Serio), undersigned, a registered patent attorney worked at Brown Rudnick from July 2000 through May 2007 and handled Stephen Almeida (Almeida) patent matters related to the Petition Patent and its related family members. In May of 2007, Serio informed Almeida that he had accepted a new position at Seyfarth Shaw and that Almeida could continue to have Brown Rudnick represent him or that he could request that Brown Rudnick transfer his files to Serio's new firm Seyfarth Shaw (Serio Decl.)

4. Serio along with several other colleagues moved their collective Intellectual Property Practices from Brown Rudnick to Seyfarth Shaw during May of 2007. As part of the transfer of client files, Serio and his colleagues instructed their respective clients to write to Sam Williams of Brown Rudnick with transfer instructions.

5. On or about May 16, 2007, Almeida, as instructed by Serio, sent instructions to Sam Williams of Brown Rudnick to transfer both his electronic and physical files to Seyfarth Shaw. (Almeida Decl. Attachment C).

6. From time to time, Brown Rudnick forwarded all mail and any U.S. Patent & Trademark Office correspondence received for the three attorneys that left to join Seyfarth Shaw; (See Exhibit C Kaps Declaration)

7. On or about September 1, 2011, June Kaps received an email from an assistant at Brown Rudnick, containing a Patent Expiration Notice for U.S. Patent 6,595,986 ('986 Expired Patent). The expiration, dated August 22, 2011, was based upon the failure to pay maintenance fees. The '986 Expired Patent was a Continuation-In-Part (CIP) application of the above captioned '074 patent, the Petition Patent (See Exhibit C Kaps Declaration and Attachment D).

8. Upon receipt of the '986 Expired Patent, Seyfarth Shaw conducted an investigation and found that it did not possess the physical file nor the electronic file associated with the '986

Expired Patent and that the issued patent was therefore not entered into Seyfarth Shaw's docketing system.

9. The next day Serio filed a petition on the grounds of an unintentional failure to pay the maintenance fees for the '986 patent, which was granted.

10. Serio and other members of the Seyfarth Shaw's intellectual property department conducted a further investigation of the reasons that Seyfarth Shaw did not possess the '986 patent. During the course of Seyfarth Shaw's investigation it discovered that the '074 parent patent (captioned above), the Petition Patent, was also not in its physical presence or electronic docketing system. (See Exhibit C, Kaps Declaration)

11. As part of its investigation Seyfarth Shaw reviewed the USPTO PAIR system and discovered that the '074 patent had also expired for failure to pay maintenance fees ('074 Petition Patent). As part of its investigation, Seyfarth Shaw requested the file wrapper for the '074 Petition Patent to see what address the Maintenance Fee Reminder and the Notice of Expiration were sent to. As with the '986 Expired Patent, the notice for the '074 Petition Patent was sent to Brown Rudnick on or about June 8, 2009 and a previously sent Maintenance Fee Reminder was sent to Brown Rudnick on or about November 17, 2008, however, neither the reminder nor the notice was forwarded to Seyfarth Shaw, as in the case of the '986 Expired Patent (See Exhibit C, Kaps Declaration, Attachment E & F);

12. As a further part of its investigation Seyfarth Shaw requested that CPI provide it with a list of the clients that were the subject of the original transfer data dump from Brown Rudnick to Seyfarth Shaw in 2007 (Exhibit C, Kaps Declaration, Attachment G). Brown Rudnick's client number 21221, which was the client number assigned by Brown Rudnick to Almeida, was not in the original data dump even though the client requested that both his physical files and related

electronic information be transferred. It appears that the physical files for Brown Rudnick's client number 21221 were also not received at Seyfarth Shaw during the initial transfer of files in 2007. (See Exhibit C, Kaps Declaration and Exhibit D, Colon Declaration).

In summary, the evidence shows that Seyfarth Shaw had a reliable docket system for ensuring timely payment of maintenance fees. The apparent file transfer error caused the required maintenance fee notices to not be processed by Brown Rudnick, and these notices were not forwarded to Seyfarth Shaw as had been the practice. Seyfarth Shaw, not being in receipt of the physical files from Brown Rudnick or the electronic files via CPI, nor the notices sent by the Patent Office, was not aware of the need to pay these maintenance fees. In other words, "but for" the file transfer error, the file would have been transferred and all subsequent events leading to non-payment of the 2nd maintenance fee would not have occurred. Thus, unavoidable delay has been shown as to non-payment of the 2nd maintenance fee.

Diligence

On September 1, 2011 Seyfarth Shaw received an email from a legal assistant at Brown Rudnick that attached notice of the expiration of the '986 patent. Immediate investigation revealed that the Petition Patent had also expired for failure to pay a 2nd maintenance fee. Petitioner first learned of the expiration on or about September 2, 2011. Serio, along with his colleagues at the Seyfarth Shaw, immediately commenced a detailed investigation of the circumstances leading to the failure to timely pay the maintenance fee. The number of individuals involved and gathering documents that go back some five years required extensive and time-consuming investigations. When all of the facts were known commencement of this petition and accompanying Declarations ensued.

CONCLUSION

Petitioner submits that a proper showing has been made that the delay in the payment of the maintenance fee due on this Petition Patent was unavoidable due to an inadvertent file transfer error.

Accordingly, acceptance, on an expedited basis, of the unavoidably delayed payment of the maintenance fee due on the Petition Patent is respectfully requested, whereby the patent will not be considered as having been expired.

The Commissioner is hereby authorized to charge any additional fees, or credit any overpayment, to Deposit Account No.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this document is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

/Seema S. White/
Seema S. White

November 8, 2011
Date: